

REMARKS

By this Amendment, Applicant amends claims 1, 6, 8, and 15. Claims 1, 3-8, 10, 11, and 14-23 are currently pending.

In the Office Action, the Examiner rejected claims 1, 3, 4, 6-8, 10, 14, and 16-18 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 6,374,112 to Widegren ("Widegren") in view of United Kingdom Patent No. 2311910A to Robinson et al. ("Robinson"); rejected claims 5, 11, and 15 under 35 U.S.C. § 103(a) as unpatentable over Widegren and Robinson in view of U.S. Patent No. 6,704,813 to Smirnov et al. ("Smirnov"); rejected claims 17, 19-21, and 23 under 35 U.S.C. § 103(a) as unpatentable over Widegren and Robinson in view of JP-11146370 to Uehara ("Uehara"); rejected claim 22 under 35 U.S.C. § 103(a) as unpatentable over Widegren and Robinson in view of Smirnov and Uehara; and rejected claim 18 under 35 U.S.C. § 103(a) as unpatentable over Widegren and Robinson in view of Uehara and further in view of U.S. Patent No. 5,159,445 to Gitlin ("Gitlin").¹

Applicant respectfully traverses the Examiner's rejection of claims 1, 3, 4, 6-8, 10, 14, and 16-18 under 35 U.S.C. § 103(a) as unpatentable over Widegren in view of Robinson, because a *prima facie* case of obviousness has not been established.

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Independent claim 1, as amended,² recites a combination including, for example, “second communication means for establishing a second radio channel with the base station and for initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means.” Widegren fails to teach or suggest at least the above listed claim elements.

The Examiner alleges that Widegren teaches “second communication means ... making communications with a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means.” (Office Action at page 3.) However, Widegren expressly teaches “selecting one of plural radio channel types when a connection associated with a radio access request is initially established.” Col. 4, lines 25-27, emphasis added. Accordingly, such teachings suggest a single radio channel, as opposed to two simultaneous radio channels, and, therefore, Widegren fails to teach “second communication means . . . for initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously,” as recited in claim 1.

Moreover, Widegren teaches that “[p]lural radio access bearers may be established and released independently to one mobile radio” (col. 3, lines 22-25) and

² Support for the claim amendments may be found in the specification, for example, at pages 12-13.

that “a radio access request is initially established by the UTRAN.” Col. 4, lines 26-31.

Widegren does not disclose initiation of an outgoing call by the mobile unit. As such, Widegren fails to teach or suggest the claimed “initiating an outgoing call from the terminal to a second communication entity … simultaneously with the first communication means,” as recited in amended amended claim 1 (emphasis added).

Robinson fails to cure Widegren’s deficiencies. Robinson teaches that “the second user interface provides higher tier communications including voice with synchronised video and fax data and text reception for display to an end user,” and “the second module 125, may also include a second processor (not shown) for processing received signals related to the communication services received signals related to the communication services provided by the second user interface 115.” Page 5, lines 23-30, emphasis added. Therefore, Robinson’s teaching of receiving different types of data with different user interfaces does not constitute “initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means,” as recited in amended claim 1.

The Examiner alleges that “Robinson . . . teaches a method of informing an operator at the terminal of information transmitted to and received from the base station over the multiple channels for each radio channel.” (Office Action at 4.)³ Even assuming the Examiner’s allegation is true, which it is not, Robinson fails to teach or

³ In the Response to Arguments Section, the Examiner alleges that “the reference inherently discloses a structure (see Fig. 3) that permit the functionality claimed to be performed i.e. informing an operator at the terminal of information transmitted to and received from the first communication entity and the second communication entity over the first and second radio channels simultaneously.” (OA at 2.) Applicant respectfully disagree with the Examiner for at least the reasons discussed in the Amendment dated February 1, 2006.

suggest at least “second communication means for establishing a second radio channel with the base station and for initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means,” as recited in amended claim 1 (emphasis added).

Therefore, neither Widegren nor Robinson, taken alone or in any reasonable combination, teaches or suggests all claim elements of amended claim 1. A *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 1. Further, because claims 3, 4, 17, and 18 depend from claim 1, Applicant also requests withdrawal of the Section 103(a) rejection of claims 3, 4, 17, and 18 for at least the same reasons stated above.

Further, independent claims 6 and 8, as amended, while of different scope, recite similar language to that of claim 1. Claims 6 and 8 are therefore also allowable for at least the same reasons stated above with respect to claim 1. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claims 6 and 8 and their respective dependent claims 7 and 10.

Regarding the Section 103(a) rejection of independent claims 14 and 16, Applicant respectfully submits that Widegren and Robinson fail to teach or suggest at least the claimed “hybrid circuitry for controlling the first radio transmitter and receiver and the second radio transmitter and receiver such that the first radio channel and the second radio channel carry communications simultaneously,” as recited in claims 14 and 16 (emphasis added). Indeed, the Office Action does not address the claimed

hybrid circuitry. Proper clarification is respectfully requested. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claims 14 and 16.

Applicant also respectfully traverses the Examiner's rejection of claims 5, 11, and 15 under 35 U.S.C. § 103(a) as unpatentable over Widegren and Robinson in view of Smirnov, because a *prima facie* case of obviousness has not been established.

Claim 5 depends from claim 1. As set forth above, Widegren and Robinson fail to teach or suggest at least "second communication means for establishing a second radio channel with the base station and for initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means," as recited in amended claim 1 and required by claim 5 (emphasis added).

Smirnov fails to cure the deficiencies of Widegren and Robinson. The Examiner alleges that Smirnov "teaches the use of a radio communication terminal further comprising storage means for storing information." (Office Action at 6.) Even assuming the Examiner's allegation is true, which Applicant does not necessarily agree, Smirnov fails to teach or suggest "second communication means for establishing a second radio channel with the base station and for initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means," as recited in amended claim 1 and required by claim 5 (emphasis added).

Therefore, none of Widegren, Robinson, and Smirnov, taken alone or in any reasonable combination, teaches or suggests all claim elements required by claim 5. A

prima facie case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 5.

Further, claim 11 depends from claim 8. Claims 8 and 15, while of different scope, recite similar language to that of claim 1. Claims 8, 11, and 15 are therefore also allowable over Widegren and Robinson in view of Smirnov for at least the reasons stated above with respect to claim 1. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claims 8 and 15.

Applicant also respectfully traverses the Examiner's rejection of claims 17, 19-21, and 23 under 35 U.S.C. § 103(a) as unpatentable over Widegren and Robinson in view of Uehara. Claim 17 depends from claim 1; claim 19 depends from claim 6; claim 20 depends from claim 8; and claim 21 depends from claim 14.

As set forth above, Widegren and Robinson fail to teach or suggest "second communication means for establishing a second radio channel with the base station and for initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means," as recited in amended claims 1 and 6; "second communication means including second transmission means for transmitting information over a second radio channel to initiate an outgoing call to a second communication entity different from the first communication entity and second reception means for receiving information over the second radio channel from the second communication entity," as recited in claim 8; or "hybrid circuitry for controlling the first radio transmitter and receiver and the second radio transmitter and receiver

such that the first radio channel and the second radio channel carry communications simultaneously," as recited in claim 14.

Uehara fails to cure the deficiencies of Widegren and Robinson. The Examiner alleges that Uehara "teaches a portable video telephone system." (Office Action at 7.) Even assuming the Examiner's allegation is true, Uehara fails to teach or suggest the above listed claim elements as recited in claims 1, 6, 8, and 14. A *prima facie* case of obviousness has not been established. Therefore, claims 1, 6, 8, and 14 are allowable over Widegren, Robinson, and Uehara. Applicant respectfully requests withdrawal of the Section 103(a) rejection of claims 17 and 19-21 for at least as being dependent from allowable base claims.

Applicant also respectfully traverses the Examiner's rejection of claim 22 under 35 U.S.C. § 103(a) as unpatentable over Widegren and Robinson in view of Smirnov and Uehara. Claim 22 depends on claim 15.

As set forth above, Widegren, Robinson, Smirnov fails to teach or suggest at least "second communication means for establishing a second radio channel with the base station and for initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means," as recited in claim 15 and required by claim 22. A *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 22.

Applicant also respectfully traverses the Examiner's rejection of claim 18 under 35 U.S.C. § 103(a) as unpatentable over Widegren and Robinson in view of Uehara and further in view of Gitlin. Claim 18 depends from claim 1 indirectly.

As set forth above, Widegren, Robinson, and Uehara fail to teach or suggest at least "second communication means for establishing a second radio channel with the base station and for initiating an outgoing call from the terminal to a second communication entity different from the first communication entity over the second radio channel simultaneously with the first communication means," as recited in amended claim 1 and required by claim 18. Gitlin fails to cure the deficiencies of Widegren and Robinson.

The Examiner alleges that Gitlin "teaches a method of displaying video images along with text images during video teleconferencing." (Office Action at 9.) Even assuming the Examiner's allegation is true, Gitlin fails to teach or suggest the above listed claim elements as recited in claim 1 and required by claim 18. A *prima facie* case of obviousness has not been established. Accordingly, Applicant respectfully requests withdrawal of the Section 103(a) rejection of claim 18.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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